

JUL 13 2006

Customer No.: 31561
Docket No.: 12646-US-PA
Application No.: 10/707,708REMARKS

Claims 1-15 are still pending. Applicants submit that a few typing errors presented in the title and Paragraphs [0028] and [0035] have been corrected hereby. Reconsideration and allowance of the application and presently pending claims 1-15 are respectfully requested.

Discussion of Rejections to Claims 8, 13 and 15 Under 35 U.S.C. §102(e)

Claims 8, 13 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Aihara et al (US 2006/0020828).

In response thereto, Applicants submit that Aihara et al is not an appropriate prior art for making a 102 (e) rejection to the present invention. As set forth in 35 U.S.C. 102:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent ...

However, Aihara et al is filed on Aug. 16, 2005. Therefore, Aihara et al was made later than the present invention having a filing date of Jan. 06, 2004. Moreover, as

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set forth in MPEP§2136.03(II)(B) :

If the international application was filed on or after November 29, 2000, but did not designate the United States or was not published in English under PCT Article 21(2), do not treat the international filing date as a U.S. filing date.

Aihara et al is a continuation of application No. PCT/JP03/06746 filed on May 29, 2003, which is designated to the United States, but not published in English under PCT Article 21(2). Therefore, the filing date of PCT/JP03/06746 cannot be treated as the U.S. filing date.

Accordingly, Applicants submit that Aihara et al is not appropriate for making a 102(e) rejection to the present invention as set forth in claims 8, 13 and 15 MPEP§706.02(f)(1) and MPEP.

Discussion of Rejections Under 35 U.S.C. §103(a)

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aihara in view of Russon (US 2003/0220894).

Applicants submit that claim 9 depends on allowable claim 8, and thus should also be allowable.

Applicants further submit that Aihara is not an appropriate prior art for making a

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103 (a) rejection to the present invention. As set forth in 35 U.S.C. 103:

(a) A patent may not be obtained though the invention is not identically disclosed or described or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Since Aihara has a filing date later than the time present invention was made, Aihara cannot be used as a prior art reference for any rejection to the present invention.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aihara in view of Russon (US 2003/0220894) and further in view of Lohn et al (US 6,950,836).

Applicants submit that claim 10 depends on allowable claim 8, and Aihara cannot be used as a prior art reference for any rejection to the present invention. As such claim 10 should also be allowable.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aihara in view of Russon (US 2003/0220894) and further in view of Lohn et al (US 6,950,836)

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and Bodnar (US 6,295,541).

Applicants submit that claim 11 depends on allowable claim 8, and Aihara cannot be used as a prior art reference for any rejection to the present invention. As such claim 11 should also be allowable.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aihara in view of Russon (US 2003/0220894) and further in view of Lohn et al (US 6,950,836), Bodnar and Dalrymple.

Applicants submit that claim 12 depends on allowable claim 8, and Aihara cannot be used as a prior art reference for any rejection to the present invention. As such claim 10 should also be allowable.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aihara in view of Bodnar.

Applicants submit that claim 14 depends on allowable claim 8, and Aihara cannot be used as a prior art reference for any rejection to the present invention. As such claim 14 should also be allowable.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russon (US 2003/0220894) in view of Dalrymple, III et al (US 2004/0107199).

In response thereto, Applicants submit that there is no suggestion or motivation

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to modify Russon with Dalrymple, and there is no reasonable expectation of success of modifying Russon with Dalrymple. Therefore claim 1 is novel and unobvious over Russon, Dalrymple, or any of the other cited references, taken alone or in combination, thus should be allowed.

The Examiner contended that Russon has disclosed that a step of "searching an application program corresponding to the application data" as searching said backup database for metadata associated with said identified image file, while the Examiner admitted that "this database is not within a registry of the electronic system". However, Applicants submit that Russon cannot be modified with any potential reference, including Dalrymple, to have the database stored in a registry, thus being able to search an application program corresponding to the application data within a registry of the electronic system, as set forth in claim 1.

Russon teaches the method may begin when a new image file is saved to the image library under management (130) (Paragraph 0041; FIG. 4). Such an image file would not be able to be stored within a registry. It should be understood by one of ordinary skill in the art that a registry is a configuration database in all 32-bit versions of Windows that contains settings for the hardware and software in the PC it is installed in. The Registry is made up of the SYSTEM.DAT and USER.DAT files. Many

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settings previously stored in the WIN.INI and SYSTEM.INI files in 16-bit Windows (Windows 3.x) are in the Registry. Therefore, although the Examiner construes the image file of Russon as an application program, such image file would definitely not be able to be stored within a registry.

Applicants submit what ever Dalrymple might have taught, he teaches nothing about that an image file could be possibly be stored and searched with in a registry.

For at least the foregoing reasons, Applicants submit claim 1 is unobvious and patentable over Russon and Dalrymple or any of the other cited references, taken alone or in combination, considered as a whole, and thus should be allowed.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russon in view of Dalrymple and further in view of Bodnar.

Applicants submit that claim 2 depends on allowable claim 1, and thus should also be allowable.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russon in view of Dalrymple and further in view of Bodnar and Lohn.

Applicants submit that claim 3 depends on allowable claim 1, and thus should also be allowable.

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Claims 4, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russon in view of Dalrymple and further in view of Aihara.

Applicants submit that claims 4, 5, and 7 depend on allowable claim 1, and Aihara is not an appropriate prior art reference for making any rejection upon the present application, and thus claims 4, 5, and 7 should also be allowable.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russon in view of Dalrymple and further in view of Aihara and Bodnar.

Applicants submit that claim 6 depends on allowable claim 1, and Aihara is not an appropriate prior art reference for making any rejection upon the present application, and thus claim 6 should also be allowable.

Claims 1, 4, 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aihara in view of Dalrymple.

Applicants submit that as discussed above addressing to the 102 rejection, Aihara is not an appropriate prior art reference for making any rejection upon the present application, and thus claims 1, 4, 5 and 7 are novel and unobvious over Aihara and any combination relying thereupon.

Therefore, Applicants submit claims 1, 4, 5 and 7 are unobvious and patentable over Aihara and Dalrymple, and thus should be allowed.

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Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aihara in view of Dalrymple and further in view of Bodnar.

Applicants submit that claims 2 and 6 depend on allowable claim 1, and Aihara is not an appropriate prior art reference for making any rejection upon the present application, and thus claims 2 and 6 should also be allowable.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aihara in view of Dalrymple and further in view of Bodnar and Lohn.

Applicants submit that claim 3 depends on allowable claim 1, and Aihara is not an appropriate prior art reference for making any rejection upon the present application, and thus claim 3 should also be allowable.

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CONCLUSION

For at least the foregoing reasons, it is believed that the pending claims 1-15 are in proper condition for allowance and an action to such effect is earnestly solicited. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

Date :

July 14, 2006

Respectfully submitted,



Ding Yu Tan

Registration No.: 58,812

Jianq Chyun Intellectual Property Office
7th Floor-1, No. 100
Roosevelt Road, Section 2
Taipei, 100
Taiwan
Tel: 011-886-2-2369-2800
Fax: 011-886-2-2369-7233
Email: Usa@jcupgroup.com.tw